

## REMARKS/ARGUMENTS

Responsive to the Office Action dated March 24, 2006, Applicant has amended Claims 1, and 12. Accordingly, Claims 1-23 remain pending for prosecution with Claims 1 and 12 being independent.

### **I. Claim Objections**

Claims 1 and 12 were objected to because “the height of the front surface greater than that of the back surfaces does not automatically create or to infer [sic] that the two sides [sic] surfaces are tapered” and “a shingle placed flat on the top will extend back . . . .” Further, it was asserted that applicant has not positively recited the tapered side surfaces. Accordingly, Applicant has amended Claims 1 and 12 and respectfully requests reconsideration and withdrawal of these objections.

### **II. Claim Rejections**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

#### **A. Rejection of Claims 1-4 and 8-13**

Claims 1-4 and 8-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al. For

the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Kirkhuff does not teach or suggest the claimed invention. In particular, Kirkhuff fails to teach a composite starter block having a unitary construction. Rather, Kirkhuff teaches a separate starter strip 70 and a separate body member 72 having a separate top plate 74 and a separate bottom plate 76. These separate components are then assembled together to form Kirkhuff's eaves starter strip. Similarly, Gleason also fails to teach or suggest a composite starter block having unitary construction. In fact, Gleason does not teach or suggest starter blocks at all. Rather, Gleason only briefly mentions that “[p]reliminary to applying panels to a roof, a metal starter strip (not shown) is nailed to the roof and extends closely adjacent and parallel to the eave.” Column 3, lines 54-56. Thus, Kirkhuff and Gleason, individually and in combination, fail to teach or suggest Applicant's composite starter block having a unitary construction.

Moreover, it is admitted in the Office Action that Kirkhuff fails to teach or suggest tapered side edges. However, it is asserted that “tapered side edges is [sic] known in the art of shingles as shown by Gleason et al., element 14, figure 3.” Applicant respectfully submits that this combination is inapposite. First, there is no teaching or suggestion in Gleason to provide a starter block at all. Gleason only teaches shingles. The sole teaching by Gleason is for a metal starter strip as discussed above. Second, Applicant respectfully submits that element 14 in figure 3 does not designate a tapered side edge at all, but rather designates the lower edge 14 of roofing panel 10. Finally, with respect to Claim 2, neither Kirkhuff nor Gleason teach a starter block wherein the width of the starter block is substantially equal to the width of the shingle. Rather, Kirkhuff teaches that the eaves starter strip may be provided with channels in the forward face

thereof to simulate division between shingles when it is fabricated in lateral lengths exceeding the length of a single shingle. Gleason teaches only a metal starter strip and does not teach that this starter strip has a width that is substantially equal to the width of the shingle. Thus, Kirkhuff and Gleason, individually and in combination, fail to teach or suggest Applicant's starter block having tapered side edges and also fail to teach or suggest a starter block wherein the width of the starter block is substantially equal to the width of the shingle.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in either Kirkhuff or Gleason to provide a composite starter block having unitary construction, tapered side edges, and a width substantially equal to the width of the shingle. Moreover, there is no expectation of success in that the combination of Kirkhuff and Gleason since neither discloses these elements of Applicant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, neither Kirkhuff nor Gleason teach or suggest all of the elements of Applicant's independent Claims 1 and 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff and Gleason fail to teach or describe all of the limitations claimed by Applicant in independent Claims 1 and 12 and the claims depending therefrom. Accordingly, Claims 1-4 and 8-13 are therefore nonobvious under § 103(a).

#### **B. Rejection of Claims 6 and 7**

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al. as

applied to Claim 1 and further in view of U.S. Patent No. 2,142,996 to Bussey. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Bussey also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Bussey merely teaches metallic shingles that are symmetrical, reversible and interlockable.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, or Bussey to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in that the combination of Kirkhuff, Gleason, and Bussey since none of these references disclose these elements of Applicant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, and Bussey all fail to teach or suggest all of the elements of Applicant's independent Claim 1. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, and Bussey, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 1 and its dependent Claims 6 and 7. Accordingly, Claims 6 and 7 are therefore nonobvious under § 103(a).

### **C. Rejection of Claims 12-15**

Claims 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 to Hardy in view of U.S. Patent No. 3,852,934 to Kirkhuff and U.S. Patent No. 4,279,106 to Gleason et al. and further in view of U.S. Patent No. 6,199,338 to Hudson, Jr.. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Hardy fails to teach or suggest the claimed invention. In particular, Hardy fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Hardy teaches that “[f]or the starting strip, a board 50 may be secured to the underside of the sheathing 10, this board extending beyond the edge of the sheathing and built up as by members 52, 52, the latter conforming in thickness to the thickness of the butt edge of the shingle.” As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Hudson also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Hudson is asserted to merely teach “a course of starter shingles of the same length as the shingles.”

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason, or Hudson to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in that the combination of Hardy, Kirkhuff, Gleason, or Hudson since none of these references disclose these elements of Applicant’s claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Hardy, Kirkhuff, Gleason, and Hudson all fail to teach or

suggest all of the elements of Applicant's independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Hardy, Kirkhuff, Gleason, and Hudson, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 12 and the claims depending therefrom. Accordingly, Claims 12-15 are therefore nonobvious under § 103(a).

#### **D. Rejection of Claim 16**

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 to Hardy in view of U.S. Patent No. 3,852,934 to Kirkhuff and U.S. Patent No. 4,279,106 to Gleason et al. and U.S. Patent No. 6,199,338 to Hudson, Jr. as applied to Claim 12 and further in view of U.S. Patent No. 5,953,862 to Earhardt. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, Hardy, Kirkhuff, Gleason, and Hudson all fail to teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Earhardt also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Earhardt is asserted to merely teach that "the nailing zone is not indented." Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason, Hudson, or Earhardt to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in that the combination of Hardy, Kirkhuff, Gleason, Hudson, or Earhardt since none of these references disclose these elements of Applicant's claimed invention. Finally, the prior art references must teach or suggest all the

claim limitations. As discussed above, Hardy, Kirkhuff, Gleason, Hudson, and Earhardt, all fail to teach or suggest all of the elements of Applicant's independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Hardy, Kirkhuff, Gleason, Hudson, and Earhardt, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 12 and the claims depending therefrom. Accordingly, Claim 16 is therefore nonobvious under § 103(a).

#### **E. Rejection of Claims 6-7 and 17-18**

Claims 6-7 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff, U.S. Patent No. 4,279,106 to Gleason et al. and U.S. Patent No. 6,199,338 to Hudson, Jr. as applied to Claim 12 and further in view of U.S. Patent No. 2,142,996 to Bussey. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, Kirkhuff, Gleason, Hudson, and Bussey all fail to teach or suggest a composite starter block having a unitary construction and tapered side edges. *Prima facie* obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, Hudson, or Bussey to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in that the combination of Kirkhuff, Gleason, Hudson, or Bussey since none of these references disclose these elements of Applicant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, Hudson, and Bussey, all fail to teach or suggest all of the

elements of Applicant's independent Claims 1 and 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, Hudson, and Bussey, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claims 1 and 12 and the claims depending therefrom. Accordingly, Claims 6-7 and 17-18 are therefore nonobvious under § 103(a).

### III. Conclusion

Applicant respectfully submits the claims are in condition for formal allowance which is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct such fees from Deposit Account No.

11-0160.

Respectfully submitted,

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